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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/591,981 | 06/12/2000 | Bruce McKendry | 0414.63308 | 3537 |

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EXAMINER

GHAFOORIAN, ROZ

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/591,981 | MCKENDRY, BRUCE |
| | Examiner Roz Ghafoorian | Art Unit 3763 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 July 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) Claim(s) 6,8 and 13 is/are allowed.
- 6) Claim(s) 7 and 10-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 June 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. Claim 11 recites the limitation "a manifold" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S Patent No. 5358476 to Wilson.

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Wilson discloses a breast pump adapter for filling infant nurses having disposable liners and method or operation. Wilson's apparatus contains a movable diaphragm in a chamber, an output port, a shaft, and a motor.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over by U.S Patent No. 5542921 to Meyers et al in view of U.S Patent No. 5358476 to Wilson and further in view of U.S Patent No. 5749850 to Williams et al.

As mentioned above Meyer discloses an electric breast pump; it contains a movable diaphragm, a chamber, with one output port, and a motor with a rotating shaft. Mayer, however, does not contain a liner or a pad. Wilson discloses a breast pump adapter for filling infant nurses having disposable liners and method or operation. Wilson teaches a liner in the chamber and teaches that liners add convenience and cleanliness to the breast extraction process. And liners also are safer to use because one does not have to wash and reuse the baby's bottle. Disposable bags also been developed to reduce the loss of nutrient when the milk is stored over a long period of time.

Williams discloses a breast pump with a pad.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the these studies. Because according to Williams a soft resilient breast cushion will increase comfort. (Col.7, lines 15-20) and according to Wilson a liners add convenience and cleanliness to the breast extraction process. And liners also are safer to use because one does not have to wash and reuse the baby's bottle. Disposable bags also been developed to reduce the loss of nutrient when the milk is stored over a long period of time. (Col.1, lines 35-42)

Allowable Subject Matter

4. Claim 6, 8 and 13 are allowed.

Regarding claims 6 and 8 combination of breast pump having a shaft, which passes though a diaphragm, and a motor that rotates around the axis of the shaft is unique and is not thought by the prior art.

Regarding claim 13 although the idea of lining is not unique the applicant claims reads on a lining which extends form the milk inlet to the milk outlet and the prior art teaches lining which begin at the milk outlet only.

Response to Arguments

Applicant's arguments filed 7-17-02 have been fully considered but they are not persuasive.

- b. The applicant argues that claim 7 should be allowed because the prior art used to reject it does not disclose a shaft with a motor that rotates around the axis of the shaft. Claim 7 does not recite the limitations of a rotatively axis

around a shaft. claim 7 recites a motor having a shaft, the shaft causing the diaphragm in a back and forth motion, which the prior art teaches.

c. Regarding claim 10-12, the applicant argues prior art does not teach a hollow boss. However, Wilson (U.S Patent No. 5358476) teaches a hollow boss 35. Furthermore, In response to applicant's argument that the prior art lack a hollow boss which prevents liner pressure from pushing a portion of the liner inwardly, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

d. Claims 11-12 are still rejected under 35 USC § 112, as mentioned in the office action in paper No.8. The applicant has amended claim 10 to over come the 112 rejections in the office action, yet claim 10 was never rejected under 35 USC 112.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Ghafoorian whose telephone number is 703-305-2336. The examiner can normally be reached on 8:30am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

RG
August 16, 2002

ANHTUAN T. NGUYEN
PRIMARY EXAMINER

8/20/02